

ESTTA Tracking number: **ESTTA274810**

Filing date: **03/27/2009**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91167207
Party	Plaintiff MS. ANITA DHALIWAL
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Date	03/27/2009
Attachments	Summary Judgment 2009.pdf ( 16 pages )(184870 bytes )

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

ANITA DHALIWAL, an Individual	)	
	)	Opposition No. 91167207
	)	Re: DVD WORLD
Opposer,	)	Serial No.: 78495856
v.	)	<b>OPPOSER'S MOTION FOR</b>
	)	<b>SUMMARY JUDGMENT</b>
	)	
DVD WORLD PICTURES CORP.	)	
	)	
Applicant.	)	

**CERTIFICATE OF TRANSMISSION**

I hereby certify that this paper is being transmitted to the Trademark Trial and Appeal Board via ESTTA on the date shown below:

Date

\_\_\_\_\_  
/R. Joseph Trojan/  
R. Joseph Trojan

\_\_\_\_\_  
March 27, 2009

**OPPOSER'S MOTION FOR SUMMARY JUDGMENT**

Opposer Anita Dhaliwal ("Opposer" or "Dhaliwal") hereby moves for summary judgment in its favor in this Opposition proceeding against Applicant DVD World Pictures Corp. ("Applicant") and respectfully requests this Board to deny the registration of the application for DVD WORLD, Serial No. 78/495856. Opposer moves for summary judgment based upon its claims of Applicant's nonexclusive rights, non-use of the mark for claimed services, lack of use as a trademark, and misuse of the ® notice.

**I. FACTS**

Opposer is the owner of the domain name [www.dvdworld.com](http://www.dvdworld.com) ("dvdworld.com or "Domain"). Opposer purchased the domain name at an Internet domain name auction site on

or about December 2, 2004 with the intent of using the domain name to sell DVDs, or, in the alternative, to resell the domain name to others. *See* Declaration of Dave Lahoti (“Lahoti Decl.”) at ¶¶2-3. Opposer purchased the domain name for \$20,010 at the auction. *Id.* At the time of Opposer’s purchase of the Domain Name, Applicant did not have a U.S. Registration for DVD WORLD. *See* Printout of Registration No. 2,912,970, *attached as Exhibit 1* to Declaration of R. Joseph Trojan (“Trojan Declaration”).

Applicant claims to sell DVDs on-line through the website [www.dvdworldonline.com](http://www.dvdworldonline.com). *See* Applicant’s Responses to Opposer’s First Request for Admissions, Answer to Request No. 9., *attached as Exhibit 22* to Trojan Declaration. On October 6, 2004, Applicant filed a federal trademark application for the word mark DVD WORLD, claiming a first date of use in commerce of November 19, 1998 for Online Retail store services and distributorships of DVD movies in International Class 35 and Motion Picture Production and Distribution in International Class 41. *See Exhibit 1* to Trojan Declaration. Applicant holds a federal trademark registration for the composite mark DVD WORLD (“composite mark”), with a registration date of December 21, 2004. Both marks have the same scope of goods and the same dates of first use and first use in commerce.

**A. Lack of Use--Ownership**

On or about December 22, 2004, Opposer received an email from John Clark of the “Legal Dept” of “The DVD World Company”, with a return email address of “legal@dvdworldcompany.com”. *See* 12/22/2004 Email from The DVD World Company, *attached as Exhibit 1* to Lahoti Decl. Applicant’s name is DVD World Pictures Corp. *See Exhibit 22* to Trojan Declaration at ¶ 4. The DVD World Company claimed ownership of the domain name [www.dvdworldonline.com](http://www.dvdworldonline.com) and alleged ownership and exclusive association of

the DVD WORLD mark in connection with the online retail sales of DVDs. *Id.* The email falsely alleged trademark infringement against Opposer for the mere registration of an inactive domain name and—astoundingly--demanded transfer of the domain name to The DVD World Company. *Id.* The email did not mention Applicant in any context.

The DVD World Company on its website at [www.dvdworldcompany.com](http://www.dvdworldcompany.com) has admitted that Applicant does not engage in the online retail sale of DVDS but is merely a “division” of The DVD World Company whose “sole purpose is to bring Major Motion Pictures worldwide under the DVD WORLD Pictures banner.” *See* Printout of the website at [www.dvdworldcompany.com](http://www.dvdworldcompany.com) on January 5, 2005, *attached as Exhibit 2* to Lahoti Decl.

Although Applicant claims to sell DVDs on the website [www.dvdworldonline.com](http://www.dvdworldonline.com), Applicant does not own the domain name [dvdworldonline.com](http://dvdworldonline.com). *See Exhibit 10* to Trojan Decl. Further, although Applicant claims to have used the DVD WORLD mark as early as 1997, Applicant did not exist at that time, as is evidenced by the fact that its first filing with the New York State Secretary of State was on January 24, 2003. *See Exhibit 21* to Trojan Decl. The DVD World Company website also admits that Applicant was founded in February 2003. *See Exhibit 2* to Lahoti Decl. To date, Applicant has failed to file any papers with the PTO claiming use(s) of the Mark by a prior entity.

**B. Lack of Use—Failure to Use as Trademark**

The DVD World Company admits that in 1997 an entity called The DVD World Company was using DVD WORLD only as a “DVD information site”. *See Exhibit 2* to Lahoti Decl.

In 1999, the DVD World Company specifically disavowed any rights in the mark DVD WORLD, stating that the company name was changed from “DVD WORLD” to the

“DVD WORLD COMPANY” in 1999 for the specific purpose of avoiding confusion with other entities. *See* Exhibit 2 to Lahoti Decl. Since that time, the [www.dvdworldonline.com](http://www.dvdworldonline.com) website DVD sale page has been called DVD WORLD ONLINE and DVD DESTINATION. *See* Archived webpages of [www.dvdworldonline.com](http://www.dvdworldonline.com) on October 17, 2000, September 26, 2001, November 21, 2002, and January 30, 2003, *attached as* Exhibits 4-7 to Trojan Decl. The website refers to itself as DVD WORLD ONLINE or THE DVD WORLD COMPANY or DVD DESTINATION in its banner, title, FAQs, Contacts, and other sections. *Id.* From 2003 to the date of this filing, the website has consistently used and referred to itself as DVD DESTINATION in all sections of the website [www.dvdworldonline.com](http://www.dvdworldonline.com), and not DVD WORLD. *Id.* The DVD World Company admits that “DVD DESTINATION” is the only division engaged in retail DVD sales. *See* Exhibit 2 to Lahoti Decl. DVD World Online currently conducts business under the name ‘DVD DESTINATION’. *See* Printout from [www.dvddestination.com](http://www.dvddestination.com) website, *attached as* **Exhibit 20** to Trojan Declaration.

***B. Lack of Use—Failure to Use Mark for Motion Picture Production and Distribution in Interstate Commerce***

Applicant claims that it has used DVD WORLD for motion picture production and distribution in interstate commerce since November 11, 1998. As stated above, Applicant did not exist until 2003. *See* Exhibit 21 to Trojan Decl., Exhibit 2 to Lahoti Decl. As of July 2006, Applicant has also admitted that Applicant has yet to use the mark in commerce, only stating that motion pictures “will be produced” and “will be released”. *See* Exhibit 16 to Trojan Decl. In its discovery responses, Applicant has only claimed several home videos as

proof of motion picture production and distribution, all within a single high school in New York state--Centerreach High School.

**C. Misuse of ® Symbol**

The ® symbol has been improperly used in conjunction with the word mark DVD WORLD as follows: DVD WORLD® ONLINE, DVD WORLD® Pictures Corp., DVD WORLD ® Distribution, DVD WORLD ® Computers, DVD WORLD ® WebCreations, and DVD WORLD ® Fundraising. *See* Exhibit 2 to Lahoti Decl.

**D. Nonexclusivity**

There are at least 206 separate domain names using DVD WORLD in the second level domain. *See* Exhibit 9 to Lahoti Decl. Many entities use DVD WORLD as a trademark for the online retail sales of DVDs. *See, e.g.,* [www.dvdworldnews.com](http://www.dvdworldnews.com), [www.thedvdworld.com](http://www.thedvdworld.com), [www.musicdvdworld.com](http://www.musicdvdworld.com), [www.sony-asia.com/dvdworld/sonydvdworld.html](http://www.sony-asia.com/dvdworld/sonydvdworld.html). Applicant and The DVD World Company were aware of other sites called DVD WORLD using the mark DVD WORLD in interstate commerce for retail DVD sales at least as early as 2000, but failed to file such statement with the PTO. *See* Printout of the website at [www.dvdworldcompany.com/DVDWorldOnline/history.html](http://www.dvdworldcompany.com/DVDWorldOnline/history.html) on January 5, 2005, *attached as* Exhibit 3 to Lahoti Decl. Although The DVD World Company has not used DVD WORLD as a source identifier since 2001, at least two other entities have continuously used DVD WORLD as a trademark in connection with online retail sales of DVDs. *See, e.g.,* Printouts of webpages at [www.dvdworld.co.uk](http://www.dvdworld.co.uk) from January and April 2001, *attached as* Exhibit 8 to Trojan Decl., Printouts of webpages at [www.dvdworldusa.com](http://www.dvdworldusa.com) on February 1, 2001., *attached as* Exhibit 9 to Trojan Decl. Internet searches for “dvd world” and “dvdworld” yield 525

million and 152,000 results respectively. *See* Google search results, *attached as* Exhibit 17 and 18 to Trojan Decl.

## II. LEGAL STANDARD

Fed. R. Civ. P. Rule 56(c) authorizes the Court to enter summary judgment where “there is no genuine issue as to any material fact and ... the moving party is entitled to a judgment as a matter of law.” The Supreme Court strongly favors summary judgment as an efficient means for resolving issues. *See Celotex Corp. v. Catrett*, 477 U.S. 317, 322-23 (1986). Proceedings before the Trademark Trial and Appeal Board ("Board") are governed by the Federal Rules of Civil Procedure, and the Board may grant summary judgment when there is no genuine issue of material fact and the moving party is entitled to judgment as a matter of law. *National Cable Television Ass'n, Inc. v. American Cinema Editors, Inc.*, 937 F.2d 1572, 1576 (Fed. Cir. 1991).

## III. ARGUMENT

A trademark is a source-identifier. Summary judgment is proper on several independent grounds and Applicant should be denied registration of the mark DVD WORLD because Applicant is improperly attempting to gain benefits for a mark it has failed to use as a trademark. As Applicant has failed to use DVD WORLD as a source identifier for its claimed services, summary judgment is proper in favor of Opposer. In addition, Applicant has deliberately misused the ® notice in violation of federal law.

### ***B. Misrepresentation Before the PTO***

Registration is improper where the applicant or registrant "knew" or "should have known" the statements made before the PTO were not true. *See, e.g., Medinol v Neuro Vasx*,

*Inc*, 67 USPQ2d 1205 (TTAB 2003); *Nougat London Ltd v Carole Garber*, Cancellation No 92040460 (TTAB 2003); *Hawaiian Moon, Inc v Rodney Doo*, Cancellation No 92042101 (TTAB 2004); *Orion Electric Co, Ltd v Orion Electric Co, Ltd*, Opposition No 91121807 (TTAB 2004); *Jimlar Corp v Montrexpport SPA*, Cancellation No 92032471 (TTAB 2004); *JEM International, Inc v Happy Rompers Creations Corp*, Cancellation No 92043073 (TTAB 2005); *Physician's Formula Cosmetics, Inc v Cosmed, Inc*, Cancellation No 92040782 (TTAB 2005).

Again, the appropriate inquiry is not into the registrant's subjective intent, but rather into the objective manifestation of that intent; the test is not whether the applicant or registrant had an intent to defraud but whether the applicant or registrant "knew" or "should have known" the statements were not true.

**1. Applicant Does Not Have Exclusive Rights In Mark and Knew So at Time of Application**

Applicant should be denied registration because the DVD WORLD mark is not distinctive; there are numerous other entities using the DVD WORLD mark and the mark lacks distinctiveness. There are at least 206 other domain names using DVD WORLD. *See* Exhibit 5 to Lahoti Decl. Many of these entities use the domain names in interstate commerce for the retail sale of DVDs. *See, e.g.,* [www.dvdworldnews.com](http://www.dvdworldnews.com), [www.sony-asia.com/dvdworld/sonydvdworld.html](http://www.sony-asia.com/dvdworld/sonydvdworld.html), [www.thedvdworld.com](http://www.thedvdworld.com), [www.musicdvdworld.com](http://www.musicdvdworld.com).

In fact, The DVD World Company was aware that others were using the mark DVD WORLD in commerce in connection with retail sales of DVDs, yet failed to state as same on its application in contravention of 15 U.S.C. §1051(a)(3)(D). *See* Exhibit 2 to Lahoti

Declaration. The test is not whether the applicant or registrant had an intent to defraud but whether the applicant or registrant "knew" or "should have known" the statements were not true. There is ample precedent finding registration improper where the applicant or registrant "knew" or "should have known" the statements were not true. *See, e.g., Medinol v Neuro Vasx, Inc*, 67 USPQ2d 1205 (TTAB 2003); *Nougat London Ltd v Carole Garber*, Cancellation No 92040460 (TTAB 2003); *Hawaiian Moon, Inc v Rodney Doo*, Cancellation No 92042101 (TTAB 2004); *Orion Electric Co, Ltd v Orion Electric Co, Ltd*, Opposition No 91121807 (TTAB 2004); *Jimlar Corp v Montrexpert SPA*, Cancellation No 92032471 (TTAB 2004); *JEM International, Inc v Happy Rompers Creations Corp*, Cancellation No 92043073 (TTAB 2005); *Physician's Formula Cosmetics, Inc v Cosmed, Inc*, Cancellation No 92040782 (TTAB 2005).

In a claim of lack of distinctiveness, the burden of proving secondary meaning is on the applicant. *Yamaha Int'l Corp. v. Hoshinko Gakki Co.*, 840 F. 2d 1572, 6 U.S.P.Q.2d 1001 (Fed. Cir. 1988), *Guess?, Inc. v. Nationwide Time, Inc.*, 16 U.S.P.Q.2d 1804 (TTAB 1990) (opposition sustained to non-inherently distinctive design where applicant had failed to prove the acquisition of secondary meaning and distinctiveness). Because Opposer is asking for freedom to continue its use of DVD WORLD, the distinctiveness of DVD WORLD must be judged as of the time of application by applicant. *De Walt, Inc. v. Magna Power Tool Corp.*, 289 F. 2d 656, 129 U.S.P.Q. 275 (C.C.P.A. 1961). Here, as of October 2004 there were at least two very prominent online retailers of DVDs using the mark DVD WORLD in interstate in a much more prominent way than either Applicant or The DVD World Company. *See* Printouts of websites of [www.dvdworld.co.uk](http://www.dvdworld.co.uk) and [www.dvdworldusa.com](http://www.dvdworldusa.com), attached as Exhibits 8 and 9 to Trojan Decl. As is evidenced by their shipping information, currency

information, and U.S. warehouse location (for [www.dvdworldusa.com](http://www.dvdworldusa.com)), both entities were actively using the mark DVD WORLD in interstate commerce. *Id.*

Accordingly, given the widespread and nonexclusive use of the DVD WORLD as well as The DVD World Company's specific knowledge of that fact, summary judgment is proper and registration should be denied as a matter of law.

## **2. Lack of Use as a Mark Prior to Registration**

Not only are there a myriad of other users of DVD WORLD, but Applicant has failed to use the mark as a trademark indicative of source. It is well established that a party's right in a trademark arises only "as a right *appurtenant to an established business or trade* in connection with which the mark is employed." *See, e.g., Buti v. Perosa*, 139 F.3d 98 (2d Cir. 1998), (quoting *United Drug Co. v. Theodore Rectanus Co.*, 248 U.S. 90, 97 (1918)) (*emphasis added*).

First, Applicant does not own the domain name it purports to use for trademark purposes; the domain name [www.dvdworldonline.com](http://www.dvdworldonline.com) belongs to an entity called DVD World Online. *See* WHOIS registration information for [www.dvdworldonline.com](http://www.dvdworldonline.com), attached as Exhibit 10 to Trojan Decl. An allegation that applicant's mark was not properly "used" in "commerce" is a proper ground for opposition to a use-based application. *See, e.g., Community of Roquefort v. Santo*, 443 F. 2d 1196, 170 U.S.P.Q. 205 (C.C.P.A. 1971); *Ft. Howard Paper Co. v. Kimberly-Clark Corp.*, 390 F. 2d 1015, 157 U.S.P.Q. 55 9ccpa 1968), *cert. Denied*, 393 U.S. 831, 159 U.S.P.Q. 799 (1968), *reh'g denied*, 393 us 971 (1968), *superseded by statute as stated in Paramount Pictures Corp. v. White*, 31 U.S.P.Q.2d 1768 (TTAB 1994). For online services, domain name is an indicator of source. *See, e.g.,*

*Brookfield Communications, Inc. v. West Coast Entertainment*, 174 F.3d 1036, 1041 (9th Cir.1999) (Domain names are indicative of origin).

Although an entity called The DVD World Company purports that Applicant is a ‘division’, The DVD World Company does not own [www.dvdworldonline.com](http://www.dvdworldonline.com). See Exhibit 10 to Trojan Decl. The DVD World Company name appears on another, identical website called [www.dvddestination.com](http://www.dvddestination.com). However, that website belongs to DVD World Online as well and not Applicant. See Exhibit 11 to Trojan Decl. Applicant has failed to file any documents with the PTO claiming prior use of the mark by a related entity in violation of §1051(a)(3). Given the various entities using the mark, usage of the DVD WORLD mark can hardly be considered indicative of source. It is well established that if the applicant identified in the application is not the owner of the mark sought to be registered, the applicant may not be amended to substitute a different entity; the application was void *ab initio*, and a new application must be filed on behalf of the true owner. See, e.g., *Celanese Corp. of Am. V. Edwin Cruthcer*, 35 U.S.P.Q. 98 (Comm. Pats. 1937); *Richardson Corp. v. Richardson*, 51 U.S.P.Q. 144 (Comm. Pats. 1941); *Dunleavy v. Koepfel Steel Prods., Inc.* 114 U.S.P.Q. 43 (Comm. Pats. 1957). Accordingly, Applicant is not entitled to registration as a matter of law and summary judgment is proper as a matter of law.

Second, even assuming *arguendo* Applicant can be somehow linked with The DVD World Company’s and/or DVD World Online’s use of the DVD WORLD mark, Applicant still must be denied registration as a matter of law because the DVD WORLD mark has not been used as a trademark. “The Supreme Court explained long ago that “the right to a particular mark grows out of its use, not its mere adoption; its function is simply to designate the goods as the product of a particular trader and to protect his good will against the sale of

another's product as his". *Buti*, 139 F. 3d 98 (quoting *Theodore Rectanus*, 248 U.S. at 97). Here, Applicant has not used the DVD WORLD mark as a trademark and, accordingly, summary judgment should be granted against Applicant.

Applicant claims usage of DVD WORLD for online retail sales of DVDs via the site [www.dvdworldonline.com](http://www.dvdworldonline.com). See However, the DVD sales site changed its name to DVD WORLD ONLINE in 2002. See Archived webpages of [www.dvdworldonline.com](http://www.dvdworldonline.com) on October 17, 2000, September 26, 2001, November 21, 2002, and January 30, 2003, attached as Exhibits 4-7 to Trojan Decl. Between January 30 and February 17, 2003, the name of the online retail store was changed again to DVD DESTINATION. *Id.* Since that time, the websites [www.dvdworldonline.com](http://www.dvdworldonline.com) (and [www.dvddestination.com](http://www.dvddestination.com)) have used DVD DESTINATION and DVD WORLD ONLINE on the websites. *Id.* The mark DVD WORLD only appears as part of a logo on the front page only; once the page for the sale of DVDs is open, there is no mention of DVD WORLD and has been none since 2003. *Id.* The FAQs, Support, and Contact pages--as well as the product viewing pages for DVDs—all refer to DVD DESTINATION after 2003 and there is no mention of DVD WORLD. *Id.* The specimen that Applicant filed with the PTO in October 2004 does not show then entirety of the webpage, which would have clearly shown the title and banner of the site to be DVD DESTINATION. See Exhibit 2 to Trojan Decl.

DVD WORLD cannot be considered to be a source indicator of Applicant in any way since the company name, the domain name, the title on the webpage, and the FAQ/Support pages all state different entities. *Id.* In fact, a consumer attempting to locate Applicant on the Internet with the mark DVD WORLD would not be able to find Applicant; a Google search would not turn up Applicant on the first five (5) pages of a search. See Search results,

attached as Exhibit 17 to Trojan Decl. A Google search for DVDWORLD would only turn up a related entity on the third page at HDDVDWORLD.COM, but would not be identifiable as Applicant in any way because the domain name as well as all descriptions would be of HDDVDWORLD, not DVD WORLD. See Search results, attached as Exhibit 18 to Trojan Decl. Finally, neither Applicant nor DVD World Online has used DVD WORLD as any metatags or key words for its websites so that any searches for DVD WORLD would lead to the source. See WHOIS information for [www.dvdworldonline.com](http://www.dvdworldonline.com) and [www.dvddestination.com](http://www.dvddestination.com), attached as Exhibits 10 and 11 to Trojan Decl. As it is clear that Applicant has made neither effort nor use of DVD WORLD as a source indicator, registration must be denied as a matter of law. 15 U.S.C. §1051(a)(3)(D)(ii).

Given the express disavowal of “DVD WORLD” for “DVD WORLD ONLINE”, the recklessly intermixed usage of DVD WORLD, DVD WORLD ONLINE, DVD DESTINATION, and HDDVDWORLD, and failure of Applicant to use DVD WORLD as any indicator of source, Applicant cannot have been to have used DVD WORLD as a trademark and summary judgment is proper against the registration of DVD WORLD.

**3. Non-Use of Mark in Connection with Claimed Scope of Services**

Applicant averred that it used the mark DVD WORLD in international commerce for motion picture production and distribution as of November 19, 1998. See Exhibit 1 to Trojan Decl. Because Applicant knew or should have known at the time of application that it had not in fact using the mark since that date, registration for International Class 41 should be denied and summary judgment is proper.

There can be no dispute of fact that Applicant had not been using the mark since the date claimed in the application. As established earlier, Applicant did not exist in 1998. See

Exhibit 22 to Trojan Decl. In addition, Applicant's website at [www.dvdworldpictures.com](http://www.dvdworldpictures.com) has stated from the inception of the website that motion pictures will be produced in the future. See Exhibit 16 to Trojan Decl. The mere mention of movies that "will go into production" or "will be released" does not constitute use in commerce. See, e.g., *Paramount Pictures Corp. v. White*, 31 USPQ2d 1768 (TTAB 1994), *aff'd without comment* 108 F.3d 1392 (Fed. Cir. 1997) (mark not registrable for games, where purported games are advertising flyers used to promote applicant's services and have no real utilitarian function or purpose as games).

Finally, the only evidence proffered by Applicant as proof of use is for the offer for sale of recorded videos of high school events at a single high school located in New York State. See Applicant's Response to Interrogatories. Applicant has submitted no evidence of advertising for such services on interstate commerce, because, in fact, it has conducted no advertising. Such use does not constitute use in interstate commerce under the Lanham Act necessary for federal registration.

***C. Misuse of the ® Symbol***

Summary judgment is also proper because Applicant has misused the ® symbol in connection with the unregistered DVD WORLD word mark.

The Lanham Act only allows use of the ® mark in connection with a registered mark. 15 U.S.C. § 1111. Fraudulent misuse of the ® symbol is grounds for opposition. See, e.g., *Wells Fargo & Co. v. Lundeen & Assoc.*, 20 U.S.P.Q.2d 1156 (TTAB 1991) (fraudulent misuse of the registration symbol can defeat an applicant's right to register and is thus a ground for opposition); *Copelands' Enterprises, Inc. v. CNV, Inc.*, 945 F. 2d 1563, 20 U.S.P.Q.2d 1295 (Fed. Cir. 1991) (reversed dismissal on summary judgment of opposition and petition to cancel grounded on fraudulent misuse of the registration symbol).

There is no dispute of material fact as to Applicant's deliberate misuse of the ® symbol. Despite having in-house counsel, The DVD World Company chose to use the ® mark wherever the words DVD WORLD used, regardless of context and of services/goods associated. *See Exhibit 2 to Lahoti Decl.* The mark was not owned by The DVD World Company and the words were not used in trademark sense. *Id.* The DVD World Company had previously disavowed rights in DVD WORLD and had announced its change in name to DVD WORLD ONLINE, and maintains this information in its current website. *See Exhibit 16 to Trojan Decl.* Despite this knowledge in 2000, DVD WORLD was improperly displayed with the ® symbol in violation of federal trademark law. *Id.* Opposer submits that such failure to prevent the negligent misuse of the statutory notice bars Applicant from registration of the DVD WORLD mark. *See Gear, Inc. v. L.A. Gear California, Inc.* 670 F. Supp. 508, 4 U.S.P.Q.2d 1192 (S.D.N.Y. 1987), *vacated, in part, dismissed* 13 U.S.P.Q.2d 1655 (S.D.N.Y. 1989) (misuse of notice on mark not registered for those goods is a ground, along with other evidence, for finding unclean hands in balancing the equities); *Copelands' Enterprises, Inc. v. CNV, Inc.*, 945 F. 2d 1563, 1568 n. 6, 20 U.S.P.Q.2d 1295, n.6 (Fed. Cir. 1991) (the failure to take any steps to end the misuse of the symbol "or to notify the Trademark Office of the past and continuing registration symbol misuse could constitute gross negligence and reckless disregard of the law").

Accordingly, given the deliberate and clear misuse of the ® symbol, Opposer submits that summary judgment is proper and that Applicant's application be denied registration.

## V. CONCLUSION

Applicant has wrongfully attempted to register a mark which it has failed to use as a trademark, a source identifier. In addition, Applicant has misrepresented its usage and non-

usage of the mark before the Patent and Trademark Office. Finally, Applicant has flagrantly disregarded requirements for trademark registration by misusing the ® symbol and by claiming usage for services it did not use in interstate commerce. For the foregoing reasons, Opposer submits that awarding registration of the mark to Applicant is improper as a matter of law and respectfully requests this Board to grant summary judgment in its favor and deny registration of the mark DVD WORLD to Applicant.

Date: March 27, 2009

Respectfully submitted,

/R. Joseph Trojan/

R. Joseph Trojan

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Attorney for Opposer Anita Dhaliwal

PROOF OF SERVICE

I am over the age of 18 years, employed in the County of Los Angeles, and not a party to the above entitled action. My business address is 9250 Wilshire Blvd., Suite 325, Beverly Hills, California 90212.

On March 27, 2009, I served:

**OPPOSER'S MOTION FOR SUMMARY JUDGMENT;**

**DECLARATION OF DAVE LAHOTI IN SUPPORT OF OPPOSER'S MOTION FOR SUMMARY JUDGMENT; and**

**DECLARATION OF R. JOSEPH TROJAN IN SUPPORT OPPOSER'S MOTION FOR SUMMARY JUDGMENT**

by transmitting to:

Mr. Edward Papetti  
President  
DVD World Picture Corp.  
63 McGaw Ave.  
Lake Grove, NY 11755  
Fax 631-471-4893

[X] BY FACSIMILE: I caused a copy of such document to be sent via facsimile machine to the office of the addressee(s) at the phone number shown above.

[X] BY MAIL: I am readily familiar with the firm's practice of collection and processing correspondence for mailing. Under that practice it would be deposited with the U.S. Postal Service on the same day with postage thereon fully prepaid at Beverly Hills, California, in the ordinary course of business. I am aware that on the motion of the party served, service is presumed invalid if the postal cancellation date or postage meter date is more than one day after the date of deposit for mailing shown on this proof of service.

[X] FEDERAL: I declare, under penalty of perjury under the laws of the United States that the foregoing is true and that I am employed in the office of a member of the bar of this Court at whose direction the service was made.

Executed on March 27, 2009, at Beverly Hills, California.

/Michiko Speier/

Michiko Speier